

No. 13333

IN THE
United States Court of Appeals
FOR THE NINTH CIRCUIT

PACIFIC CONTACT LABORATORIES, INC., MORRIS GREEN,
and LEE W. HOGGAN,

Appellants,

vs.

SOLEX LABORATORIES, INC.,

Appellee.

APPELLANTS' OPENING BRIEF.

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APPELLANTS' OPENING BRIEF.

This is an appeal by the defendants below from a final judgment of the United States District Court for the Southern District of California, Central Division [R. 21], in an action for infringement of the two claims of United States Letters Patent No. 2,510,438 [Ex. 1; R. 239] and for trade-mark infringement.

Jurisdiction.

Original jurisdiction is vested in the District Court by 28 U. S. C. 1338-a, and jurisdiction to review the appealed judgment is vested in this court by 28 U. S. C. 1292(4). Final judgment [R. 21] was entered December 7, 1951. Motion for new trial was filed by appellants on December 17, 1951 [R. 24] and was denied January 3, 1952 [R. 39]. Notice of appeal was filed February 1, 1952 [R. 45].

Statement of Case.

Appellee (who was plaintiff below and is hereinafter referred to as plaintiff) charged appellants (who were defendants below and are hereinafter referred to as defendants) with infringing United States Letters Patent No. 2,510,438, issued to K. M. Tuohy [Ex. 1; R. 239], relating to contact lenses.

Defendants were also charged with trade-mark infringement, because of their use of the descriptive term “cornea lens” to describe their corneal contact lenses; plaintiff alleging that it had a trade-mark right in the term “corneal lens.”

The judgment held the two claims of the patent in suit valid and infringed and also restrained defendants from using the term “cornea lens” to describe their product.

Contact lenses are a type of eye glass in which the lens fits in contact with the eyeball, as distinguished from being mounted in a frame.

In so far as physical structure is concerned, a contact lens is nothing more than a transparent, concavo-convex shaped piece of glass or plastic ground to correct deficiencies in vision. Contact lenses are old in the art. For an early contact lens patent, see *Volle* patent No. 722,059, issued March 3, 1903 [Ex. H; R. 251]. Because they are worn in direct contact with the eyeball, and are therefore somewhat irritating to the eye [R. 137], their use has been and still is rather limited.

Contact lenses are held against the eyeball by surface tension with the eye fluids. Where the eye fluids are in-

sufficient, they are supplemented by so-called buffer solutions.

The earliest contact lens had a concavo-convex central portion which covered only the cornea or “limbus” portion of the eye, and had a surrounding flange which extended over a part of the white or “scleral” portion of the eye and under the eyelids, called the “scleral flange.” Such a lens is shown by the above-mentioned *Volle* patent [Ex. H], wherein the corneal portion is indicated by the numeral 1 and the scleral flange is indicated by the numeral 2. *Lincke* patent 2,000,768 [Ex. G; R. 248], also shows such a lens. This type of contact lens is known as the “scleral” type.

Gradually, it was found that, in some cases, the scleral flange could be eliminated, leaving only the corneal portion. This lens without the flange became known as the “corneal” type lens. The Tuohy patent in suit relates to this type of lens. A book, Obrig, “Contact Lenses,” published in this country in 1942, describes the old Kalt corneal lens. See quotation from this book at page 15 of the Tuohy file wrapper [Ex. 2]. Long before patentee Tuohy entered the field in 1948, Dr. Green, one of the defendants in this case, made corneal lenses, in 1946, by trimming the scleral flanges from some scleral type lenses [R. 135-7, 149; Ex. 3].

Both types of contact lens are the same in construction except that one has the scleral flange and the other does not.

Eye doctors and oculists have used various techniques of fitting contact lenses. For instance [Ex. I; R. 255], a publication called "The Optician"; and [Ex. K; R. 265] an excerpt from the February, 1946 issue of "The Optometric Weekly," describe various techniques.

While the Tuohy patent in suit is an *article* patent, purporting to cover lens construction, in reality it merely describes a technique or *method* of fitting a corneal lens on the eye in a way to leave clearance for the eye fluids. The method involves an indefinitely expressed relationship between the radius of the lens and the radius of the eye which it is to fit.

Mr. Tuohy did not apply for his patent until 1948. He was employed by Obrig at the time Obrig published his above-mentioned book "Contact Lenses" in 1942, so that he obviously knew of the Kalt lens described in that book.

After the trial, defendants discovered important new evidence of the early history of contact lenses, and moved for a new trial in order to be able to produce this evidence [R. 24]. Dr. Green's affidavit [R. 28]; Dr. Peter C. Kronfeld's affidavit [R. 30]; and an article "How New is the Corneal Lens," published in "The Ophthalmic Dispenser" of May, 1950 [R. 32], accompanying the motion, are most illuminating, and certainly indicate that, before granting a final judgment enabling patentee Tuohy to appropriate the techniques developed by various technicians over the years, the Trial Judge should have reopened the case and heard the newly discovered evidence which the defendants had been unable to discover before the trial. However, the Trial Judge denied the motion for new trial.

Specification of Errors.

Defendants submit that the trial court erred:

(1) In holding that the patent in suit discloses anything involving patentable invention;

(2) In holding the patent in suit valid despite the fact that its claims fail to describe the alleged invention with the particularity and certainty required by the statute;

(3) In holding that a patent containing only article claims can monopolize a method of using the article;

(4) In awarding attorneys' fees;

(5) In denying defendants' motion for new trial based upon important newly discovered evidence; and

(6) In restraining defendants from using the descriptive term "cornea lens" to describe their corneal lenses.

The errors specified under paragraphs 1, 2 and 3 are raised by paragraphs 1, 2, 3, 4, 5 and 6 of defendants' concise statement of points on appeal [R. 233].

The error specified under paragraph 4 is raised by paragraph 7 of said concise statement of points on appeal.

The error specified under paragraph 5 is raised by paragraphs 8 and 9 of said concise statement of points on appeal; and

The error specified in paragraph 6 is raised by paragraphs 10 and 11 of said concise statement of points on appeal.

Summary of Argument.

Point 1: THE PATENT IN SUIT, ITS PROSECUTION BEFORE THE PATENT OFFICE, AND THE PRIOR ART.

(a) Patentee Tuohy did not invent the corneal type contact lens.

(b) The patent in suit fails to disclose anything requiring the exercise of inventive genius.

(c) The claims of the patent in suit fail to describe the alleged invention in the clear and definite manner required by the statute.

(d) A method invention cannot be validly patented by an article patent.

Point 2: THIS IS NOT A CASE IN WHICH AN AWARD OF ATTORNEYS' FEES IS PROPER, EVEN IF IT SHOULD BE FOUND THAT PLAINTIFF IS ENTITLED TO PREVAIL.

Point 3: IT IS SUBMITTED THAT THE TRIAL COURT ABUSED ITS DISCRETION IN REFUSING TO GRANT DEFENDANTS' MOTION FOR NEW TRIAL UPON THE GROUND OF NEWLY DISCOVERED EVIDENCE.

Point 4: THE TRIAL COURT ERRED IN HOLDING THAT A PURELY DESCRIPTIVE WORD CONSTITUTES A TRADE-MARK.

(a) The terms "corneal lens" and "cornea lens" are merely descriptive of corneal lenses.

(b) The trial court was without jurisdiction to determine the issue of infringement of an alleged common-law trade-mark in the absence of diversity of citizenship of the parties.

ARGUMENT.

POINT I.

The Patent in Suit, Its Prosecution Before the Patent Office, and the Prior Art.

(a) Patentee Tuohy Did Not Invent the Corneal Type Contact Lens.

In applying for his patent, Mr. Tuohy claimed to be the inventor of the corneal type contact lens. For instance, claim numbered 7 of his application as filed, read:

“7. A contact lens applicable to the cornea of the human eye consisting of a generally convex section of transparent or semi-transparent material and characterized by being disposed wholly within the limbus of the eye to which it is applicable.” [Ex. 2, p. 10.]

However, in its first action [Ex. 2, p. 13], the Patent Office rejected the claims upon the above mentioned Obrig book,* the pertinent excerpt from which is quoted at page 15 of Exhibit 2, as follows:

“About the same time that August Muller was experimenting with contact lenses, an optician, E. Kalt, independently carried on an investigation of his own. He ground some small lenses to correct keratoconus *which had no scleral band, and rested at the edge of the cornea. They were designed to exert some pressure on the apex of the conus* in an attempt to reduce the ecstasia as well as to correct the visual error.”

Mr. Tuohy then acquiesced in the rejection by the Patent Office by canceling his claims [Ex. 2, p. 87]. He thus

*The book was not entered as a separate exhibit because the most pertinent part, that describing the Kalt lens, was quoted as a part of the file history of the Tuohy patent, Ex. 2 [R. 185].

admitted that the corneal type lens was old and is estopped to assert otherwise.

Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 126, 86 L. Ed. 736;

American Can Co. v. M. J. B. Co. (9th Cir.), 48 F. 2d 144, 146.

The Patent Office suggested to Mr. Tuohy that, if he had invented anything, it was a method of fitting an old corneal lens on the eye, and suggested that he refile his application as one for a method patent [Ex. 2, p. 89]. Mr. Tuohy did not refile his application as suggested, but inserted, by amendment, two *method* claims [see claims numbered 11 and 12, Ex. 2, p. 88], which the Patent Office rejected for lack of sufficient disclosure in the specification [Ex. 2, p. 94]. Mr. Tuohy then acquiesced in this rejection by canceling those claims [Ex. 2, p. 97].

However, Mr. Tuohy, by having his attorney personally interview the Patent Office Examiner, finally persuaded the Examiner to allow the two claims of the patent. While those claims are *article* claims, they recite as their alleged novelty, a *method* or technique of fitting a lens on an eye.

Claim 1 of the patent [R. 239] reads as follows:

“1. A contact lens applicable to the human eye comprising a concavo-convex lens formed of light-transmitting material having a marginal size smaller than the limbus portion of the eye to which it is applicable but larger than the maximum iris opening, said lens having a radius of curvature on its concave side slightly greater than the radius of curvature of the cornea to which it is applied so that radially from the center of the lens there will be a small but gradually increasing clearance for the entry of natural eye

fluids between the lens and the cornea, said lens being ground to correct for visual deficiency.”

Claim 2 is essentially the same except that it specifies that the edge of the lens is beveled, to make it smoother.

Thus, if we eliminate from the claims, as we must, the statement of the function of the lens, the only physical structure which it describes is “a concavo-convex lens formed of light transmitting material.”

(b) The Patent in Suit Fails to Disclose Anything Requiring the Exercise of Inventive Genius.

Corneal lens structure as described by the Tuohy patent claims was old, as shown by the description of the Kalt lens in the Obrig book; by the lenses made by Dr. Green in 1946 [Ex. 3. R. 149]; by the description of the “Gualdi” lens in the publication “The Optician” [Ex. I, R. 255]; and by the corneal portions of the contact lenses of the Lincke patent 2,000,768 [Ex. G, R. 248], and the Volle patent 722,059 [Ex. H; R. 251]. Tuohy also acquiesced in the holding of the Patent Office that the structure was old.

The necessity for having clearance between the lens and the eye to allow for the eye fluids was recognized by all opticians [See Ex. I; R. 255].

The alleged novelty in the Tuohy patent claims is the recital that the lens so fits the cornea that a fluid space is provided—or, in the language of the patent, “so that radially from the center of the lens there will be a *small* but gradually increasing clearance for the entry of natural eye fluids between the lens and the cornea.” However, all alleged novelty in that is negated by the Kalt lens described in the above-mentioned Obrig book. Kalt tried

his corneal lens upon an eye afflicted with keratoconus (an eye affliction in which the cornea has an acutely conical shape [R. 219]), in an attempt to reduce the ecstasia of the keratoconus. The lens was so shaped that it exerted its pressure on the apex of the cone, so that it had to have a radius larger than that of the cornea onto which it was fitted. While the Kalt lens described in the Obrig book did not reduce the ecstasia of the keratoconus, it was also ground to correct vision deficiencies, and, as a prior publication, the Obrig book describes a corneal lens for vision correction, which is the only purpose of the Tuohy lens.

Tuohy was employed by Obrig when the latter published the description of the Kalt lens in 1942 [R. 61]. Then, six years later, after leaving Obrig's employ, Mr. Tuohy filed application for the patent in suit, claiming as his own invention that which Obrig had described, except that Tuohy couched his patent application in more technical language.

Even if we disregard the fact that the Kalt lens was designed to fit the eye in the same manner as the Tuohy lens, with all the above discussed art before him Mr. Tuohy certainly was not called upon to exercise any flash of genius to make his lens flare outwardly from the apex of the cornea to provide a fluid clearance.

As a matter of fact, the Tuohy patent specification does not treat the particular manner of providing this clearance as of any great moment. For instance, in his patent, page 3, column 1, lines 63 *et seq.*, he states that the mere grinding of the lens for optical correction may provide the necessary clearance for the eye fluids.

Beveling the edges of an article, to make it smooth, is a conventional procedure in all arts. In any event [Ex.

J; R. 264], shows contact lenses having beveled and rounded edges. Consequently claim 2 of the Tuohy patent is also fully met.

Thus, according to the tests of invention laid down by the Supreme Court in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 86 L. Ed. 58, and applied by this court, Mr. Tuohy has failed to make a patentable invention.

(c) The Claims of the Patent in Suit Fail to Describe the Alleged Invention in the Clear and Definite Manner Required by the Statute.

35 U. S. C. A. 33 provides as follows:

“Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, *in such full, clear, concise, and exact terms* as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall *particularly point out and distinctly claim* the part, improvement, or combination which he claims as his invention or discovery.”

It will be recalled that the Tuohy patent claims, after reciting an old concavo-convex transparent lens of the corneal type (of a size to fit the limbus portion of the eye),

attempt to distinguish by reciting that the lens has a radius of curvature “slightly” greater than that of the cornea

“to which it is to be applied so that radially from the center of the lens there will be a ‘small’ but gradually increasing clearance for the entry of natural eye fluids between the lens and cornea.”

It is apparent, therefore, that, before any manufacturer of corneal lenses could form an opinion as to whether a given lens is within the Touhy patent claims, he would have to follow the lens through the oculist into the hands of the patient upon whom it was eventually fitted, and then measure the patient’s eye to determine its curvature. He would then have to form an opinion as to whether the lens was only “slightly” greater in curvature than the radius of curvature of the eye; and he would also have to form an opinion as to whether or not there was a “small” clearance, and whether the clearance was such that the eye fluids could effectively enter between the lens and cornea, or whether the clearance was too great to enable the lens to be held in position by surface tension with the eye fluids. The patent claims do not recite, *except in terms of function*, what clearance there should be, but leaves that to experimentation. Even after making all those experiments and forming all those conclusions, the result would not be conclusive, because human eyes undergo changes in shape from time to time. A particular lens upon a particular patient might be an infringement today but tomorrow it might not be, and vice versa—not because of any act of the manufacturer, but because of acts of nature.

According to the testimony of plaintiff's expert [R. 215] this clearance is a critical matter. The expert testified that if there is too much clearance, the lens is apt to fall off the eye. He also testified that an improperly fitted Tuohy lens would injure the eye. *This the patent claims leave this critical matter to experimentation and conjecture, describing it only in terms of function.*

In other words, a lens manufacturer would not only have to consult a patent lawyer, but also an eye doctor, to obtain an opinion as to whether a particular lens infringed the patent, and even that opinion would be debatable as well as temporary.

The patent statute has never contemplated that there should be such uncertainty, or that a manufacturer should be required to conduct experiments and draw conclusions therefrom as to whether his product infringes a patent.

In *Standard Oil Co. v. Tide Water Associated Oil Co.*, 154 F. 2d 579, a case involving patent claims of this type, the court said (pp. 582-583):

“The public policy of §4888 has been clearly expressed by the Supreme Court. ‘The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others, and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must “inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.” The claims “measure the invention.” . . .

In a limited field the variant must be clearly defined.' *General Electric Co. v. Wabash Appliance Corp., et al.*, 1938, 304 U. S. 364, 369, 58 S. Ct. 899, 902, 82 L. Ed. 1402. The same language is used in *United Carbon Co. et al. v. Binney & Smith Co.*, 1942, 317 U. S. 228, 232, 63 S. Ct. 165, 168, 87 L. Ed. 232. The latter decision goes on to point out that 'The courts . . . no less than the parties-litigant, need and may insist upon the precision enjoined by the statute.' The public policy behind the statute may be seen to be as strongly grounded in the necessity for adequate notice as it is in the necessity to teach. The burden is on the inventor to say precisely what he has done. He must speak so clearly that he does not shift that burden to others who because of his failure to be more explicit may unwittingly invade the field covered by the patentee.

"The most immediate test of sufficiency of precision in description following from the policy just outlined is that no inventor may compel independent experimentation by others to ascertain the bounds of his claims. This Court in the *Standard Brands* case so ruled before and the Supreme Court in the same case agreed. Equally necessary in derivation is the rule that difficulty in securing exactness does not mean a description may fall short of the requirements of the statute. In the *General Electric* case, *supra*, the Supreme Court said, 'The Circuit Court of Appeals below suggested that "in view of the difficulty, if not impossibility of describing adequately a number of microscopic and heterogeneous shapes of crystals, it may be . . . the best disclosure possible . . ."' But congress requires, for the protection of the public, that the inventor set out a definite limitation of his patent; that condition must be satisfied before the monopoly is granted.' "

In *Vitamin Technologists v. Wisconsin Alumni Research Foundation* (9th Cir.), 146 F. 2d 941, in discussing such claims, this court said (pp. 949-50):

“Assuming that Dr. Steenbock made a novel discovery of process and product, the discoveries, however valuable, do not automatically become patented by the filing of applications disclosing them. In addition to the disclosure, the applicant must ‘particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention and discovery’ as required by 35 U. S. C. A. §33. In *United Carbon Co. v. Binney & Smith*, 317 U. S. 228, 63 S. Ct. 165, 87 L. Ed. 232, in holding invalid a claim because of the indefiniteness of the area of infringement, the Supreme Court followed *General Electric Co. v. Appliance Wabash Corp.*, 304 U. S. 364, 369, 58 S. Ct. 899, 901, 82 L. Ed. 1402, which there states:

“‘. . . Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirements as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others, and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must “inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.” The claims “measure the invention.” ’

“Appellant contends, and we agree with it, that the phrase of all the claims of the first and second

patents, describing the function of exposure as ‘for a period *sufficient* to effect antirachitic activation but so limited as to avoid subsequent *substantial injury* to the antirachitic principle,’ is too vague and uncertain a description of the process to ‘inform the public . . . of the limits of the monopoly asserted.’ ”

In *In re Statmann*, 146 F. 2d 290, the Court of Customs and Patent Appeals, in holding that a patent claiming structure must distinguish over the prior art in terms of structure rather than in terms of function or method, stated (p. 292):

“ . . . the statement in the claims as to the method of applying the caps is entirely functional and, since the claims are not drawn to method but to structure, in order to be patentable they must distinguish from the prior art by structural limitations. This principle is so elementary that it is not necessary to cite authorities.”

(d) A Method Invention Cannot Be Validly Patented by an Article Patent.

Under the patent statute, a machine, an article of manufacture, or a composition of matter, is a “thing” and may be protected by an *article* patent. But a method or process is fundamentally different and may only be protected by a *method* patent.

Burr v. Duryee, 1 Wall. 531, 17 L. Ed. 650.

A controlling consideration here is that the Tuohy patent is an article patent, and yet, at the very point which Tuohy asserts that there is novelty, he claims his alleged invention in terms of method, or the function which the

lens is to perform. Even if Mr. Tuohy had disclosed anything novel in the method of fitting a corneal lens upon an eye (and any such novelty is negated by the *Obrig* book), still he cannot validly monopolize it by an article patent.

A leading case directly in point is *Nestle-Le Mur Co. v. Eugene*, 55 F. 2d 854 (6th Cir.), which fully reviews the authorities in point. There the patentee had discovered, in the permanent waving of hair, that it was advantageous to apply the heat for a longer period near the roots of the hair. The court observed that perhaps the method was new but that the patentee had elected to patent the machine, which was not new, instead of patenting the method, saying:

“ . . . Having discovered a new and useful method, which we assume was patentable as such . . . , a machine patent was applied for and issued upon an unpatentable device. This was an error in judgment and administration for which the courts cannot and should not afford a remedy.”

In holding the patent invalid, the court further said:

“ . . . little prejudice could result from an inventor's indecision as to whether his invention should properly be the subject of a patent for a machine or an article of manufacture, or a composition of matter. These three subjects of patent are in a true sense all products or articles, but all differ fundamentally in nature from a process. *Cf. Burr v. Duryee*, 1 Wall. 531, 568, 17 L. Ed. 650. The latter is not a ‘thing.’ It may be protected and patented only as a process, and failure to observe this distinction is here fatal.”

POINT II.

This Is Not a Case in Which an Award of Attorneys' Fees Is Proper, Even if It Should Be Found That Plaintiff Is Entitled to Prevail.

Patentee Tuohy entered the corneal lens field and applied for his patent in 1948.

The uncontradicted and corroborated [R. 190] evidence shows that the defendant, Dr. Green, who also owns the corporate defendant, commenced his work in corneal lenses in 1946, at which time he made and used corneal lenses [Ex. 3] by taking old scleral contact lenses and cutting off the scleral flange [R. 135]. Consequently, it is obvious that Dr. Green did not enter the field with any knowledge of any patent of Mr. Tuohy.

There is no evidence that at any time Mr. Tuohy or the plaintiff notified defendants of the patent in suit either before or after it issued on June 6, 1950, and this suit was instituted shortly thereafter, in October, 1950.

It is true that Dr. Green purchased some of the Tuohy lenses in 1949, after plaintiff commenced offering them to the public, and plaintiff handed Dr. Green some of its literature; but the literature was also handed to others in the profession and of course was not of a confidential nature.

It is believed to be the policy of the courts, certainly in this circuit, not to award attorneys' fees as a general thing, but only where wilful conduct or bad faith is shown. (*Dubil v. Rayford Camp Co.*, 184 F. 2d 899 (9th Cir.)) There is no showing of wilful conduct or bad faith warranting any award of attorneys' fees in this case.

POINT III.

It Is Submitted That the Trial Court Abused Its Discretion in Refusing to Grant Defendants' Motion for New Trial Upon the Ground of Newly Discovered Evidence.

Since corneal lenses had their origin in Europe, it was impossible for defendants, despite diligent effort, to locate, in time for the trial of this case, users of those corneal lenses which were exported to and used in this country years ago.

However, as shown by the affidavits of Dr. Green [R. 28] and Dr. Peter C. Kronfeld [R. 30], attached to the motion for new trial [R. 24], defendants did discover after the trial, some of those lenses, the users thereof, and additional illuminating facts about the history of the lenses. Another thing discovered by defendants after the trial was a publication, "The Ophthalmic Dispenser," attached as Exhibit "B" to the motion for new trial [R. 32]. While this publication, in itself, was not early enough to be anticipatory of the Tuohy patent, it does contain an article written prior to issuance of the Tuohy patent, by one of the pioneers in the contact lens field, giving a chronological history of corneal lenses, and from which defendants would have been able to locate important evidence.

It is submitted that, particularly in a case like this, where an individual, by a patent of highly questionable validity, is attempting to appropriate the techniques gradually developed in the profession over the years, the trial court should have allowed ample opportunity to the defendants to place the full history of the art before the court. By denying defendants' motion for new trial, the trial court denied this right to defendants.

POINT IV.

The Trial Court Erred in Holding That a Purely Descriptive Word Constitutes a Trade-mark.

(a) The Terms "Corneal Lens" and "Cornea Lens" Are Merely Descriptive of Corneal Lenses.

While the complaint alleges [R. 4], that plaintiff has some trade-mark right in the term "corneal lens," and while the trial court has attributed to the term a trade-mark significance, it appears too obvious to admit of such argument that the term is purely descriptive and, consequently, is incapable of constituting a trade-mark.

Webster's New International Dictionary lists "cornea" as a noun and "corneal" as the adjective. Throughout the record, in describing the lenses involved, all witnesses have necessarily had to refer to them as corneal lenses, because that is the only manner in which they can be described.

There is no evidence establishing any secondary meaning of the term. In fact, the only testimony as to plaintiff's use of the term appears at R. 110, where plaintiff's witness Mr. Gordon testified as follows:

"We are *trying* to establish the words 'corneal lenses' as our trade-mark for our brand of contact lenses. We have an application for federal registration of the words 'corneal lenses' and 'Tuohy corneal lenses' now pending."

There is no showing that the trade-mark was ever registered.

The findings of fact certainly do not support a judgment to the effect that “corneal lenses” constitutes a trade-mark or has acquired any secondary meaning. Finding 13 [R. 17] contains the only thing in the findings about the subject. It reads as follows:

“The plaintiff, both before and since the issuance of the patent in suit has been exploiting the patented lenses by manufacturing, using, and selling the same under the names of ‘Corneal Lens’ and ‘Tuohy Corneal Lens’ and includes among purchasers of its lenses departments of the Government of the United States.”

The law is well settled that no one may prevent another from using a common, descriptive dictionary word to describe his product.

“A name which is merely descriptive of the ingredients, qualities, or characteristics of an article of trade cannot be appropriated as a trade-mark and the exclusive use of it afforded legal protection. The use of a similar name by another to truthfully describe his own product does not constitute a legal or moral wrong, even if its effect be to cause the public to mistake the origin or ownership of the product. *Delaware & H. Canal Co. v. Clark*, 13 Wall. 311, 323, 327, 20 L. Ed. 581, 583, 584; *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, 220 U. S. 446, 453, 55 L. Ed. 536, 540, 31 Sup. Ct. Rep. 456; *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U. S. 118, 140, 49 L. Ed. 972, 986, 25 Sup. Ct. Rep. 609.”

Warner & Co. v. Lilly & Co., 68 L. Ed. 1161, 1163.

(b) The Trial Court Was Without Jurisdiction to Determine the Issue of Infringement of an Alleged Common Law Trade-mark in the Absence of Diversity of Citizenship of the Parties.

There is no diversity of citizenship of the parties [R. 21], and, even if the term “corneal lens” could be said to have the status of a valid trade-mark, it has not been registered and would therefore constitute only a common law trade-mark.

In *Dubil v. Rayford Camp Co.*, 184 F. 2d 899, 901, this court considered similar facts and held that the issue of a common law trade-mark was a non-federal cause of action and that the trial court was in error in entering judgment upon the issue, citing *Hurn v. Oursler*, 289 U. S. 238, 77 L. Ed. 1148.

Conclusion.

For the reasons hereinbefore stated, defendants respectfully submit, therefore, that the judgment appealed from should be reversed and plaintiff’s complaint dismissed; or, at least, that the case should be remanded to the trial court with directions to hear the newly discovered evidence and then to enter new findings, conclusions and judgment.

Respectfully submitted,

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